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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/879,309	06/12/2001	Pauline Shulman	40101/01901	5159
30636	7590	11/17/2004	EXAMINER	
FAY KAPLUN & MARCIN, LLP 150 BROADWAY, SUITE 702 NEW YORK, NY 10038			STEVENS, THOMAS H	
			ART UNIT	PAPER NUMBER
			2123	

DATE MAILED: 11/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/879,309

Applicant(s)

SHULMAN ET AL.

Examiner

Thomas H. Stevens

Art Unit

2123

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 June 2001.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 12-15 is/are pending in the application.  
4a) Of the above claim(s) 1-11 and 16-19 is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 12-15 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 12-15 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

1. Claims 1-19 were reviewed.
2. Claims 1-11 and 16-19 were withdrawn.

***Restriction***

3. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-11 are drawn to methods of software upgrading to a network, classified in class 717, sub-class 171.
  - II. Claims 12-15 are drawn to methods of emulation, classified in class 703, sub-class 23.
  - III. Claims 16-19 are drawn to methods of software program development tool, source code version; classified in class 717, sub-class 122.
4. Inventions of Groups I and III are related as subcombinations disclosed as usable together in a single combination, while Groups I/III are distinct from Group II.

Inventions I and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention III has separate utility such as emulation. See MPEP § 806.05(d).

In the instant case, the invention of group I has a separate utility dealing with software upgrading to an established computer network while group III is software development. Group II has a separate utility of emulation. These are separate uses, which distinguish the invention of each of the latter groups from one another and is a separately useable subcombination. See MPEP § 806.05 (d).

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and/or recognized divergent subject matter, restriction for examination purposes as indicated is proper.

6. During a telephone conversation with Michael Marcin, Registration number 48198, on 11/9/04 a provisional election was made without traverse to prosecute the invention of Group II, claims 12-15. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-11 and 16-19 were withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

7. Claims 12-15 were examined.

***Claim Objections***

8. In claims 12-15, the examiner objects to the use of the word "system" because of its ambiguity to statutory type and suggest the use of "apparatus" or "machine".

***Claim Rejections - 35 USC § 112***

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

10. Claim 14 recites the limitation " the software application". There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 12-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Zeanah et al. (U.S. Patent 5,933,816 (1999)). Zeanah et al. teaches a delivery system and method for financial services to a plurality of remote devices (abstract).

Claim 12. A system, comprising: a plurality of device emulation environments (column 28, lines 55-58), each of the device emulation environments emulating the operation of

a corresponding target device (columns 28,29, lines 66-67 and 1-5, respectively); a server coupled to the plurality of device emulation environments and accessible to a user computer via a communications network (column 7, lines 5-8), wherein the server runs a software package including a first interface module receiving from the user data corresponding to a software application to be run on a first one of the target devices, a second interface module selecting a first one of the device emulation environments corresponding to the target device and installing the software application in the first device emulation environment and a testing module testing the performance of the software application in the first device emulation environment (test device with host of emulators across development languages; columns 28,29, lines 66-67 and 1-5, respectively).

Claim 13. The system according to claim 12, (column 28, lines 55-58) wherein the first interface outputs the results of the test (abstract: lines 23-26) to the user computer via the communications network (column 7, lines 5-8).

Claim 14. The system according to claim 13, (column 28, lines 55-58; abstract: lines 23-26; column 7, lines 5-8) wherein the software package running on the server further comprises an operating system building module receiving data from a user regarding the target device and desired functionality of the operating system and assembling the software application from stored components based on the target device (columns 28,29, lines 66-67 and 1-5, respectively) and desired functionality (column 29, lines 52-65).

Claim 15. The system according to claim 13, (column 28, lines 55-58; abstract: lines 23-26; column 7, lines 5-8; column 29, lines 52-65) wherein the software package running on the server further comprises a scheduler module monitoring usage (columns 10-11, lines 50-67, 1-11) of each of the plurality of device emulation environments and indicating to the user times (Inherent) at which the first device emulation environment is available.

***Correspondence Information***

13. The prior art of record made and not relied upon is considered pertinent to Applicants' disclosure. References to Lim et al. (U.S. Patent 6,795,966 is cited as teaching a computer checkpoint system.


Reference to Autrey et al., (U.S. Patent 5,774,695 is cited as teaching a protocol interface gateway that is connected to a telecommunication systems emulator.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mr. Tom Stevens whose telephone number is (571) 271-0365, Monday-Friday (8:00 am- 4:30 pm) or contact Supervisor Mr. Kevin Teska at (571) 272-3716. The fax number for the group is 703-308-1396.

Any inquires of general nature or relating to the status of this application should be directed to the Group receptionist whose phone number is (571) 272-1400

November 10, 2004

THS

  
**SAMUEL BRODA, ESQ.**  
**PRIMARY EXAMINER**